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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,171	02/25/2002	Marjorie Faith Zarin	03292.101250	8691

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EXAMINER
NEWTON, JARED W

ART UNIT	PAPER NUMBER
3693	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)	
Office Action Summary	10/082,171	ZARIN ET AL.	
	Examiner	Art Unit	
	JARED W. NEWTON	3693	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _25 April 2008_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _59-67,69-75,77-81,83-91 and 93-105_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _59-67,69-75,77-81,83-91 and 93-105_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This final rejection is in reply to the remarks filed April 25, 2008, by which claims

59, 77, 83, and 100 were amended. Claims 59-67, 69-75, 77-81, 83-91, and 93-105 are

pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 59-67, 77-81, 83-91 and 100-105 are rejected under 35 U.S.C. 102(e) as

being anticipated by US Patent Application Publication No. 2002/0156723 to Lilly et al.

(hereafter Lilly).

In regard to claim 59, Lilly discloses a computer implemented method for

facilitating a transaction account approval, the method comprising the steps of:

receiving an access code 720A (see FIG. 7A);

determining, based on the access code, whether an accessing party is a pre-

existing customer (see [0111-0114] -- Lilly recites,

"Once the customer has completed shopping at the web site, the customer may

decide to check out ... Server 612 recognizes the customer's request to complete

the transaction and redirects processing to a credit card issuer offer decision

processes (Step 718A) ... Once management information system receives the

appropriate credit card information, it analyzes the card information against data

stored in customer registration database 616 (Step 720A) ... [I]n the event the

customer has not been offered an extra credit line, (Step 722A; YES), an extra

credit line offer page is generated based on the features previously described

herein. The offer may be generated based on the features previously described

herein."

In view of this recitation, it is inherent that the system must first determine

whether the "customer" is an existing customer (who is eligible for an account upgrade),

or a new customer (who is eligible for a new account), and that that determination is

based on the access signal received.

Lilly further discloses determining, if the accessing party is a pre-existing

customer, whether at least one pre-approved offer customized for the pre-existing

customer exists (see [0039]-[0043] -- Lilly recites, "The offers may vary for each

customer based on the credit worthiness determined in Step 210 (see FIG. 2).

In regard to claim 60, Lilly further discloses the accessing party as a pre-

existing customer and the step of determining whether at least one pre-approved offer

exists for the pre-existing customer further comprises matching the access code to a

pre-existing customer profile (see [0053] – [0054]) in a pre-existing customer database

(see [0012]).

In regard to claim 61, Lilly further discloses the pre-approved offer as associated with the pre-existing customer profile (see [0054]).

In regard to claim 62, Lilly further discloses providing the pre-approved offer in an application for a transaction account (see e.g. [0109]).

In regard to claim 63, Lilly further discloses the step of providing the customer profile in the form of a plurality of modifiable entry fields (see [0053] – [0056]).

In regard to claim 64, Lilly further discloses the step of allowing the customer to validate his profile (see [0057]).

In regard to claim 65, Lilly further discloses the step of approving the application for the transaction account, wherein the approving step is performed in real-time and wherein the transaction account is associated with transaction account information (see [0114]).

In regard to claim 66, the method disclosed by Lilly includes providing transaction account information.

In regard to claim 67, the method disclosed by Lilly includes modification of the data entry fields (see [0065]).

In regard to claims 77-81, Lilly discloses the limitations as set forth above, and further discloses the method as applied to prospective customers who are not existing customers of the credit issuer.

In regard to claims 83-91 and 101-105, the claimed limitations are deemed anticipated by the Lilly reference as applied to claims 59-67 and 77-81 above. Lilly discloses the method as set forth in those rejections and further discloses a system,

including a plurality of servers and customer interfaces for carrying out the method (see

e.g. [0069] and [0100]).

In regard to claim 100, Lilly further discloses the server as configured to

process the application for the transaction account under a predetermined processing

procedure associated with an ineligible accessing party; and to provide a message

informing that the application for the transaction account is processed under the

predetermined processing procedure (see, e.g., [0052]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 69-75 and 93-99 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Lilly, as applied to claims 59-67, 77-81, 83-91 and 101-105 above,

alone.

In regard to claim 69, Lilly discloses the receipt of an access code as set forth

above in the rejection of claim 59, and further discloses the generation of customized

offers for individual customers (see [0043] – [0045]), wherein said offers are stored in

and processed by a credit issuer database 1300 (see [0039]). Lilly does not explicitly

disclose matching the access code to a pre-approval code. However, it would have

been obvious to one of ordinary skill in the art at the time of the invention to associate

the access codes received with a pre-approval code, or identifier that associates an

individual customer with the offer customized for him. It is well known in the art of

database storage to associate a code or identifier, which represents a first segment of

information, with a data entry that represents a second segment of information, in order

to store information more efficiently and to search for information more easily. For

instance, if each pre-approved offer disclosed by Lilly included an identifier, and the

identifier of each offer was associated with a customer's access code in the database

1300, then the credit issuer would be able to quickly access the offers available to a

customer each time the customer's access code is received. Such a storage method is

well known and commonly employed for associating a customer with financial data,

credit data, geographical data, and the like.

     In regard to claim 70, Lilly further discloses providing the pre-approved offer in

an application for a transaction account (see e.g. [0109]).

     In regard to claim 71, Lilly further discloses the step of providing the customer

profile in the form of a plurality of modifiable entry fields (see [0053] – [0056]).

     In regard to claim 72, Lilly further discloses the step of allowing the customer to

validate his profile (see [0057]).

     In regard to claim 73, Lilly further discloses the step of approving the application

for the transaction account, wherein the approving step is performed in real-time and

wherein the transaction account is associated with transaction account information (see

[0114]).

In regard to claim 74, the method disclosed by Lilly includes providing

transaction account information.

In regard to claim 75, the method disclosed by Lilly includes modification of the

data entry fields (see [0065]).

In regard to claims 93-99, the claimed limitations are deemed unpatentable

over the Lilly reference as applied above. Lilly discloses the method as set forth in those

rejections and further discloses a system, including a plurality of servers and customer

interfaces for carrying out the method (see e.g. [0069] and [0100]).

With respect to the above rejections, the Examiner has cited particular portions of

the reference(s), and although the specified citations are representative of the teachings

in the art and are applied to the specific limitations within the individual claim, other

passages and figures may apply as well. It is respectfully requested that the Applicant

consider each cited reference in its entirety as potentially teaching the limitations of the

claimed invention.

Response to Arguments

In view of the Amendments filed April 25, 2008, the Claim Rejections under 35

U.S.C. 112 set forth in the Office Action mailed January 25, 2008 are hereby withdrawn.

Applicant's arguments filed April 25, 2008 have been fully considered but they

are not persuasive. In particular, Applicant's arguments focus on an alleged deficiency

in the Lilly reference. Applicant recites, "Lilly fails to even mention prospective

customers for the purpose of extending pre-approved offers specially tailored to the

individual prospective customer's profile." (Remarks, page 13). Applicant's arguments

fail for two reasons. First, the Lilly reference directly contradicts Applicant's argument by

explicitly reciting, "the goods and/or services offered at the web site may be purchased

by customers using a variety of different credit cards, including cards not issued by the

card issuer hosting the site" (see [0108]). The method of Lilly then must determine

whether the customer is a pre-existing customer or a new customer, in order to

determine which offer to extend the customer. Accordingly, the Examiner contends that

Lilly meets the limitation of claim 59 requiring "determining . . . whether an accessing

party is a pre-existing customer of a card provider or a prospective customer of the card

provider."

     Second, with respect to "prospective customers," claim 59 requires "determining

if the accessing party is a prospective customer, the validity of the access code, and if

the access code is valid, associating the access code with at least one of a customer

profile and a pre-approved offer customized based on the customer profile." In view of

this recitation, any required action with respect to a prospective customer is conditional

on the method first determining that the customer is a prospective customer. In other

words, if the method does not determine that the customer is a prospective customer,

then it does not require a determination of "the validity of the access code" and

"associating the access code with at least one of a customer profile and a pre-approved

offer customized based on the customer profile." Accordingly, if a prior art method

determines that the returning customer is not a prospective customer, the method need

not include the noted recitation in order to anticipate the claim, because the condition

that the customer is a prospective customer will not have been met. Assuming,

arguendo, that Applicant's characterization of the Lilly reference is correct, Lilly would

still anticipate claim 59 because it discloses an embodiment where the method

determines that the customer is a pre-existing customer of the card provider (that is, the

method does not determine that the customer is a prospective customer), and therefore,

the claim 59 recitation regarding the prospective customer need not be shown.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JARED W. NEWTON whose telephone number is

(571)272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

JWN
July 22, 2008

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/082,171	ZARIN ET AL.	
	Examiner	**Art Unit**	
	JARED W. NEWTON	3693	